

## DETAILED ACTION

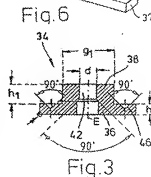
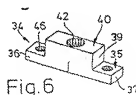
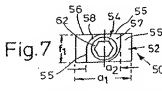
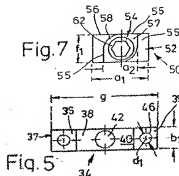
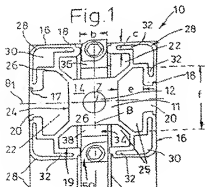
### *Election/Restrictions*

Claims 83-103 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species (in accordance with p.10 of applicant's remarks filed 1/13/2010), there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/5/2008. As noted in the 1/13/2009 interview, elected Species 1 has been combined with species 2 to form a single elected species of figures 1-11.

### *Drawings*

The drawings are objected to for the following:

- Figure 1 is not complete since shows only a partial incomplete view of element 50 (upper 50 and lower 50 of figure 1 are not complete). Note that portion 52 (belonging to 50 as seen in figure 7) is not present in figure 1. Further note the lower element 50 as seen in figure 1 does not completely show the entire perimeter of portion 57 as seen in figure 7. Lastly note that figure 1 fails to show a border line between 36 and 52. See figures 1 and 3-7 below too compare.



- Pencil and non black ink not permitted. See 37 CFR 1.84(a).
- The lines, numbers & letters not uniformly thick and well defined, clean, durable, and black (poor line quality). See 37 CFR 1.84(l).
- The hatching for elements 46 (figure 6), 42 and 48 (figure 12), 70a (figure 22), 70b (figure 25), 71 (figure 27), 71 (figure 32) is incorrect. Note that external surfaces may not be shaded with cross hatching. See MPEP § 608.02.

Corrected drawing sheets in compliance with 37 CFR 1.84 and 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 74-82 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention without undue experimentation; or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. In accordance with MPEP§2164, there is doubt "about enablement because information is missing about one or more essential parts or relationships between parts which one skilled in the art could not develop without undue experimentation". See *In re Wands*, 858 F.2d731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) and note the following so-called *Wands* factors:

- The nature of the invention and breadth of the claims is drawn to a connected assembly comprising first and second hollow profiles connected by a connector having a screw element (50) mounted onto the stepped face (35) of the biteplate (36) of the socket profile (34). Note that the elected species stepped face has conical depressions (46) rather than the screw holes (48) of the non-elected species, such that the elected species having conical depressions cannot effect the claimed "mounted" limitation of claim 74 by screwing (since it does not have screw holes, only depressions).

- The state of the prior art is such that screw elements and socket profiles are mounted to one another by screwing a screw into screw holes (similar to applicant's non-elected species having screw holes 48). The prior art does not show mounting of screw elements to socket profiles via conical depressions (such as applicant's elected species having conical depressions 46).
- The level of one of ordinary skill does not allow for effecting connection between an element having a flat surface and another element having a conical depression.
- The level of predictability in the art does not allow for speculation as to how a flat surface would be connected to a conical depression.
- The amount of direction provided by the inventor is negligible. A brief mention of the depressions (46), of the elected species, is made in paragraph 0061 but only to state that they can be replaced with screw holes (48), of the non-elected species.
- No working examples of the conical depression species are presented or known to exist as claimed.
- Accordingly, the quantity of experimentation needed to make or use the invention based on the content of the disclosure is immense since applicant's disclosure gives no direction for experimentation. Any known non-screw hole method such as gluing, taping, welding, soldering, etc. would appear to render the conical depressions unneeded rather than explain how such depressions can effect connection.
- Applicant must amend the written description to describe how the conical depressions (46) of the elected species act to effect the claimed "mounting" with enough detail to enable one skilled in the art to which it pertains, or with which it is most nearly

connected, to make and use the invention without undue experimentation. If such explanation cannot be made without the addition of new matter than a continuation in part should be filed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 74-82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear how the elected species having conical depressions (46), rather than the non-elected screw holes (48) can allow for the claimed "mounting" (lines 30-33 of claim 74). It appears that additional unknown elements (see 112 1<sup>st</sup> rejection above) are necessary to allow the claimed "mounting" of the elected species having depressions (46). Accordingly the claim is incomplete for omitting essential elements and cooperative relationships of elements, such omission amounting to a gap between the elements and structural connections. See MPEP § 2172.01.

For the reasons mentioned above a great deal of confusion and uncertainty exists as to the proper interpretation of the claim limitations. In accordance with the MPEP § 2173.06, rejection under 35 U.S.C. 102 or 35 U.S.C. 103 of the claims as currently written would be improper since doing so would require considerable speculation about the meaning of terms employed in the claims and assumptions as to the scope of the claims. However, the references cited on the attached PTO form 892 fairly represent the relevant prior art.

***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

***Conclusion***

Applicant's amendment (filed 11/3/2009 and 1/13/2010) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

January 19, 2010

/Victor MacArthur/  
Primary Examiner, Art Unit 3679